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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/728,748

12/02/2000

Heather Philpott

PH-17

2377

26841

7590

12/19/2006

MARK P. BOURGEOIS

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OSCEOLA, IN 46561

EXAMINER

PARA, ANNETTE H

ART UNIT

PAPER NUMBER

1661

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/19/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/728,748	<b>Applicant(s)</b> PHILPOTT, HEATHER	
	<b>Examiner</b> Annette H. Para	<b>Art Unit</b> 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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### **Status of Application**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 6, 2006 has been entered.

Applicant's remarks and the affidavit of Michael.L. Dunnett filed July 6, 2006 have been entered and fully considered but are not found persuasive as to the issues set forth in this Office action. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### **Claim Rejection**

Claim 1 remain rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right publication number 971485 published on February 16, 1998 in the European Community, in view of applicant's admission that 'Glory' was sold in Europe in May 1998 (page 2 of reply filed July 19, 2005).

### **Response to Arguments**

Applicant's arguments filed July 6, 2006, have been fully considered and the following arguments are not considered persuasive for the following reasons:

Applicant argues that the sale of plants of Veronica Glory was an isolated solitary event that was not available to the general public. Applicant then argues that the general public would not have had knowledge of sales of Veronica Glory because the sale took place under the name 'Royal Candles'. This argument is not persuasive because 100 plants were sold to Blakedown Nurseries to build up a stock of plants. Then 20 plants approximately were further sold to the recognition of the applicant in the spring of 1999 on a market-testing basis. In order to run a market-testing basis the customer had to place these plants in possession of public. This would indicate that one of ordinary skill in the art would have been in possession of the claimed plant and would have known where to obtain the claimed plant. Does a name

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change obscure the issue that one of skill in the art would have been able to purchase the plant? Does a name change obscure the issue that the sale was not a single, isolated, occurrence? Does a name change mean that one of the ordinary skill in the art would not have been able to propagate the plant? The Examiner believes that this is not the case for each of the posed interrogatories and the name of the plant is irrelevant. The "how to make" and "use" requirement has been met. One of the ordinary skill in the art would have been able to obtain the plant and make/use the plant based on the previous cited evidence, thus enabling the publication. If all Applicants need do, is change the name of the plant, then conceivably any plant from overseas could be sold here under a different name and not infringe any intellectual property rights. Moreover, the Plant Breeder's Application lists the inventors name, address and telephone number and assignee name. For applicant to state that one of the ordinary skill in the art would be unable to purchase the plant under a different name and not know it was the same plant is not a valid argument. One cannot overlook the fact that when contacted by one of the ordinary skill in the art, the breeder, eager to sell, would indicate to the former that the plant is available and sold under another name. It is clear that a difference in names does not obscure the fact that one of ordinary skill in the art could have bought the plant, as the sale was not a single, isolated occurrence, and could have reproduced the plant since asexual reproduction of euphorbia is well documented in the art, thus enabling the Plant Breeder's Right grant.

By using the referenced publication, one of skill in the art would have been able to contact the Applicant, Breeder, and Title Holder of the plant in question (information included on the referenced publication) and subsequently obtain a plant since it was being marketed by Applicant's own admission.

It is generally recognized that *prior public use and sale of a plant are the avenues by which a plant enters the public domain*. See, e.g., *LeGrice*, 133 USPQ at 370-71. The PBR publication when considered in combination with the knowledge of one skilled in the art, i.e., the availability of the plant in the public domain as evidenced by sale of the claimed plant more than one year prior to application for patent, places the plant in the public domain, and therefore is enabled since one skilled in the art would have been able to reproduce that exact same plant through asexual means.

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All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H Para whose telephone number is (571) 272-0982. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 4:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax number for the organization where the application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about PAIR system, see <http://pair-direct.uspto.gov> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Annette H Para

*Kent J. Bell*